- I, Alessandro Vitale, currently residing at via Ciro Menotti 33, 20133 Milano, Italy, European Union, do hereby declare:
- 1. I am not one of the inventors or applicant of US 10/535,433, a copy of which I have read and understood. I have no commercial relationship with the inventors or applicant of US 10/535,433. Between April 1996 and August 1998 Dr Lorenzo Frigerio, an inventor of US 10/535,433, worked as a post-doctoral research associate in my laboratory at the Institute for Plant Biology and Biotechnology, National Research Council, Milano, Italy.
- 2. I am an expert in the field of the invention. My curriculum vitae is enclosed.
- 3. I have published over 80 scientific papers and book chapters. These are listed in the attached Annex.
- 4. In the Official Action from the United States Patent and Trademark Office, dated 21 June 2007, the Examiner believes that the claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. I disagree. The Examiner also believes that the application does not provide sufficient information to allow one skilled in the art to repeat the invention across the full breadth of the claims. I disagree.

I declare that one skilled in the art as of the filing date of the present application (May 18, 2005) would have been able to repeat the claimed invention across its full breadth using the teaching of the application as filed in combination with his common general knowledge. The inventor has identified the underlying principle to whether an immunoglobulin expressed in a plant is to be secreted or directed towards a vacuole. One skilled in the art would be able to generate mutations in the C terminal 18 amino acids of an immunoglobulin and then test whether the mutated immunoglobulin possessed a vacuolar targeting signal (i.e. the 'principle biological property' of the claimed invention). There is not an infinite number of possible mutations. The claimed mutations lie within the C-terminal 18 amino acids of the immunoglobulin. There is no need to provide one skilled in the art with each and every possible nucleotide sequence and amino acid sequence. I believe that US 10/535,433 provides a sufficient number of representative species of sequences to demonstrate that the invention works across the whole claimed genus of sequences.

Furthermore, the skilled person could easily test whether the mutated immunoglobulin retained the antigen-binding specificity of the parent (i.e. non-mutated) immunoglobulin. Such tests were within the skills of undergraduate biology students as of May 18, 2005, hence the skilled person would have no difficulty in carrying out such a test.

I also believe the application as filed shows that the inventor, as of the filing date of the application, had possession of the full scope of the invention as now claimed. For example, page 8, line 1 through the top of page 10 of the application describes the broad scope of the invention and various aspects of modifications to the C-terminus 18 amino acids of the heavy chain. While the text does not specifically delineate each and every possible individual modification, I believe the application as filed shows that the inventor had possession of the claimed method, including modifying the nucleotide sequence that encodes the

immunoglobulin heavy chain to form a modified nucleotide sequence, wherein the modifying is in the region of the nucleotide sequence encoding the C-terminus 18 amino acids of the immunoglobulin heavy chain to remove, or reduce the effectiveness of, one or more vacular targeting signal sequences of the encoded immunoglobulin heavy chain.

In summary, I declare that the claims clearly describe the invention and that one skilled in the art would be able to repeat the claimed invention without undue experimentation.

5. The Examiner believes that the claimed invention is obvious in view of the teachings of Frigerio et al (Plant Physiology 123: 1483-1493 (August 2000) (hereinafter "Frigerio") in combination with one or more of Vitale and Raikhel (Trends in Plant Science 4(4): 149-155 (April 1999)) (hereinafter "Vitale"), Koide et al (Plant Cell Physiol. (40(11): 1152-1159 (1999)) (hereinafter "Koide"), Matsuoka and Neuhaus (J. Exp. Bot. 50: 165-174 (1999)) hereinafter ("Matsuoka")). I disagree.

I declare that I am a co-author of the Frigerio and Vitale publication. As a person skilled in the art of the field of this invention at the time the present application was filed, I declare that, prior to the present application, it was not known or obvious that proteins originating from mammals, in particular humans, that are synthesized by the secretory pathway, contain cryptic sorting signals that cause those mammalian proteins, in particular human proteins, to be targeted to a particular location within the cell when expressed in a plant, The only known exception is default secretion, which does not require additional signals apart from the signal peptide to enter the secretory pathway.

I declare that the constructs and methods of the present invention are novel and not obvious as compared to the methods and antibodies disclosed in Frigerio et al (Plant Physiology 123: 1483-1493 (August 2000) (hereinafter "Frigerio"), Vitale and Raikhel (Trends in Plant Science 4(4): 149-155 (April 1999)) (hereinafter "Vitale"), Koide et al (Plant Cell Physiol. (40(11): 1152-1159 (1999)) (hereinafter "Koide"), Matsuoka and Neuhaus (J. Exp. Bot. 50: 165-174 (1999)) hereinafter ("Matsuoka").

I declare that Frigerio relates to the expression of immunoglobulin, i.e. a mammalian protein, in a plant. Frigerio identifies that the protein is delivered to two different sites in the plant: a proportion of molecules is transported to the vacuole and a proportion of molecules is secreted. However, Frigerio does not identify the underlying reason for the protein being delivered to two different sites of the plant. Frigerio does not identify a cryptic signal in the amino acid sequence of an immunoglobulin. Instead, Frigerio predicts that the reason might be:

- (i) Due to autophagy by the vacuole, through unkown recognition events
- (ii) Due to the presence of thiol-mediated retention in the plant ER [endoplasmic reticulum], similar to thiol-mediated retention reported in mammalian cells (see page 1489, left hand column).
- (iii) Due to the presence of conformational defects of tetramers or decamers that lead to their prolonged ER retention and eventual slow degradation (see page 1489, left hand column). That is, because of the large size of the protein.
- (iiii) Due to saturation of secretion, because of the high level of synthesis. This was considered very unlikely on the basis of what is known about the process of secretion.

Furthermore, the Discussion of Frigerio states "This raises the problem of which are the mechanisms and recognition events that lead to vacuolar delivery of a protein that is

expected to be secreted". The Discussion states "To be delivered to the vacuole, soluble proteins need sorting signals; when these signals are deleted, the mutated proteins are secreted, albeit with variable efficiencies (Bednarek et al., 1990, Crofts et al., 1990, Although one potential receptor for vacuolar sorting has been identified, the mechanisms for vacuolar delivery are not yet fully clarified, and certainly more than one mechanism exists (Vitale and Raikhel, 1999). However, we were unable to demonstrate tight binding of IgA/G to endomembranes." This clearly shows that Frigerio had doubts about whether a targeting mechanism existed.

Thus it is clear that at the date of publication of Frigerio, the person skilled in the art did not know whether a targeting signal existed.

As a person skilled in the art of the field of this invention at the time of filing the present application, I would not have combined the teachings of Frigerio with those of Vitale, Koide or Matsuoka. This is because Vitale, Koide and Matsuoka discuss the expression of plant proteins in a plant. In contrast, Frigerio discusses the expression of a mammalian protein in a plant. The person skilled in the art would not expect a mammalian protein to possess a targeting signal which can be recognised for the delivery to plant vacuoles. Defective antibodies are disposed of in mammals by an entirely different route.

- 1. I expected IgA/G to cause endoplasmic reticulum stress, but this was experimentally ruled out.
- 2. I expected IgA/G to be subjected to quality control in the endoplasmic reticulum, with subsequent disposal in the vacuole. This however was also experimentally ruled out

Therefore, the identification of a targeting signal in a mammalian protein, as described in the present invention, is far from obvious.

In conclusion, I believe that the teachings of Frigerio, taken alone or in combination with Vitale, Koide and/or Matsuoka, would not have provided any motivation to generate the claimed invention, and would not render the present invention obvious. This is because it was surprising to discover that the underlying reason for heterologous mammalian protein being directed to the vacuole was due to the presence of a targeting signal. The degree of surprise is confirmed by the three years of research that was required to identify these facts.

I declare further that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine, or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such wilful false statements may jeopardize the validity of any patent issuing on this application.

Alessandro Vitale

18 October 1007

# ALESSANDRO VITALE CURRICULUM VITAE AND PUBLICATIONS

SURNAME:
GIVEN NAME:
DATE OF BIRTH

Vitale Alessandro

DATE OF BIRTH: CITIZENSHIP:

February 11, 1953

Italian

MARITAL STATUS:

married, one son

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## Education, career and employment

| 2002-<br>present | Research Director, Istituto di Biologia e Biotecnologia Agraria (CNR, Agricultural Sciences). Field of activity: plant molecular and cell biology, plant biotechnology  |
|------------------|---|
| 1996-<br>2001    | Senior Researcher, Istituto di Biologia e Biotecnologia Agraria (CNR, Agricultural Sciences). Field of activity: plant molecular and cell biology   |
| 1986-96          | Researcher, Istituto Biosintesi Vegetali - former denomination of IBBA - (CNR, Agricultural Sciences). Field of activity: plant molecular and cell biology  |
| 1982-83          | Visiting scientist (awarded a CNR fellowship) in the laboratory of Maarten J. Chrispeels, UCSD, La Jolla, CA, to study the biosynthesis, intracellular transport and processing of bean phytohemagglutinin. Field of activity: plant cell biology           |
| 1982-86          | Researcher, Istituto Biosintesi Vegetali, CNR<br>Field of activity: plant biochemistry and cell biology   |
| 1978-82          | Awarded a fellowship from CNR, Agricultural Sciences, to work at the Istituto Biosintesi Vegetali, Milano on the biochemical characterization and cell biology of maize storage proteins.  Field of activity: plant biochemistry, cell biology and genetics |
| 1971-76          | Degree (Laurea) in Biology, Università degli studi di Milano. Mark: 110/110.<br>Field: Biochemistry   |

#### Teaching

Academic years 2004-2006
Academic years 2008-2006
Academic years 2008-2008
Academic years 2008-2

# Responsabilities

2006-09 Contractor of the European Commission Marie Curie Research Training Network "Vacuolar Transport Equipment for Growth Regulation in Plants" EU Sixth Framework Programme.

| 2006-<br>present<br>2004-07 | Member of the Editorial Board of Plant & Cell Physiology   |
|-----------------------------|--|
|                             | Contractor of the Integrated Project "Recombinant Pharmaceuticals from Plants for Human Health". EU Sixth Framework Programme.   |
| 2003-05                     | Member of the Scientific Committee of the Istituto di Genetica Agraria, CNR  |
| 2003-05                     | Member of the Direction of the Italian Society of Plant Physiology   |
| 2002- 05                    | Research Unit Leader within the project "Post genomics of forage legumes", supported by the Fondo per gli Investimenti della Ricerca di Base (FIRB) of the Ministery of Research of Italy.   |
| 2003                        | Member of the Italian delegation for the renewal of the Science and Technology Cooperation Agreement between Italy and the United States of America.   |
| 2002- 06                    | Associated Contractor of the Research Training Network EU: "Biochemical and genetic approaches to study bio-molecular interactions in plants" EU Fifth Framework Programme.  |
| 1999-2004                   | Co-Editor of The Plant Cell  |
| 1997-2003                   | Editorial Consultant of Plant Biosystems   |
| 1997-2000                   | Member of the Scientific Committee of the Istituto biosintesi vegetali, CNR, Milano.   |
| 1997-2000                   | Member of the Scientific Committee of the Istituto di nematologia agraria applicata ai vegetali, CNR, Bari.  |
| 1995-97                     | Associated Contractor of the Project "Analysis of functional components and mechanisms controlling the plant endomembrane system", supported by the EU "Human Capital and Mobility" programme.   |
| 1994-<br>present            | Editor of <i>Planta</i>  |
| 1994-<br>present<br>1990-93 | Member of the Advisory Board of Journal of Experimental Botany   |
|                             | Research unit leader within the Progetto Finalizzato "Biotecnologie e Biostrumentazione" of the CNR. Project title: "Molecular biology of protein intracellular traffic and production of new proteins with determined locations".   |
| 1990-91                     | Research unit leader within the Progetto Speciale di Comitato del CNR "PS0408 – mechanisms responsible for the intracellular localization of proteins". Project title: "Assembly and intracellular traffic of phaseolin, the major storage protein of common bean"   |
| 1987-<br>present            | Research Project leader at the Istituto di Biologia e Biotecnologia Agraria, CNR (formerly Istituto Biosintesi Vegetali). Research topics: seed storage proteins, molecular interactions and protein traffic within the plant secretory pathway, use of plants as bioreactors for the production of recombinant pharmaceuticals. |

# Honours, memberships

2005 - present

Member of the Italian Society for Agricultural Genetics (SIGA - Società Italiana di genetica Agraria)

1999 - present. Member of the American Society of Plant Biologists

1998 - Awarded the "Assunta Baccarini-Melandri" Prize of the Italian Society of Plant Physiology

1998 - present.Member of the Italian Society of Plant Physiologists (SIFV - Società Italiana di Fidsiologia Vegetale)

## Plenary lecture speaker at International meetings (last three years)

First Academia Belgica-Francqui Conference "Plants for the Future". Roma May 18, 2006. Title of presentation: Protein synthesis and accumulation in the plant secretory pathway.

Annual Meeting of the Korean Society for Molecular and Cellular Biology, October 17-18, 2005, Seoul, Korea. Title of presentation: Protein accumulation in the plant endoplasmic reticulum: relationships with protein quality control.

The Rank Prize Funds, Mini-Symposium on Improving the Plant Secretory System for Nutrition and Health. Grasmere, UK, 23rd to 26th May, 2005. Title of presentation: Functional and biochemical aspects.

#### LIST OF PUBLICATIONS

#### Solicited papers

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Vitale, A., Ceriotti, A. and Denecke, J. (1993) The role of the endoplasmic reticulum in protein synthesis, modification and intracellular transport. J. Exp. Bot. 44, 1417-1444.

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Frigerio, L., Pedrazzini, E., Giovinazzo, G., Bollini, R., Ceriotti, A. and Vitale, A. (1996) The synthesis of phaseolin: a model for the study of the plant secretory pathway. **Giorn. Bot. Ital.** *130*, 891-900.

Vitale, A., and Denecke, J. (1999) The endoplasmic reticulum, gateway of the secretory pathway. Plant Cell 11, 615-628.

Vitale, A. and Raikhel, N.V. (1999) What do proteins need to reach different vacuoles?. **Trends Plant Sci.** 4, 149-155.

Vitale A. and Galili, G. (2001) The endomembrane system and the problem of protein sorting. Plant Physiol. 125, 115-118.

Vitale, A. (2001) Uncovering secretory secrets: inhibition of endoplasmic reticulum (ER) glucosidases suggests a critical role for ER quality control in plant growth and development. Plant Cell 13, 1260-1262.

Vitale, A. Physical methods. (2002) Plant Mol. Biol. 50, 825-836.

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Vitale, A. and Hinz, G. (2005) Sorting of proteins to storage vacuoles: how many mechanisms? Trends Plant Sci. 10, 316-323.

Vitale A. and Pedrazzini E. (2005) Recombinant pharmaceuticals from plants: the plant endomembrane system as bioreactor. **Mol. Interv.** 5, 216-225.

#### Research papers

Longo, G.P., Longo, C.P., Rossi, G., Vitale, A. and Pedretti, M. (1978) Variations in carbohydrate and lipid content and in osmotic potential of watermelon cotyledons treated with benzyladenine. Plant Sci. Lett. 12, 199-207.

Vitale, A., Soave, C. and Galante, E. (1980) Peptide mapping of IEF zein components from maize. Plant Sci. Lett. 18, 57-64.

Bollini, R. and Vitale, A. (1981) Genetic variability in charge microheterogeneity and polypeptide composition of phaseolin, the major storage protein of *Phaseolus vulgaris*; and peptide maps of its major subunits. **Physiol. Plant.** 52, 96-100.

Vitale, A., Smaniotto, E., Longhi, R. and Galante, E. (1982) Reduced soluble proteins associated with maize endosperm protein bodies. J. Exp. Bot. 33, 439-448.

Bollini, R., Vitale, A. and Chrispeels, M.J. (1983) *In vivo* and *in vitro* processing of seed reserve protein in the endoplasmic reticulum: evidence for two glycosylation steps. J. Cell Biol. 96, 999-1007.

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Chrispeels, M.J., Vitale, A. and Staswick, P. (1984) Gene expression and synthesis of phytohemagglutinin in the embryonic axes of developing *Phaseolus vulgaris* seeds. **Plant Physiol.** 76, 791-796.

Vitale, A., Ceriotti, A., Bollini, R. and Chrispeels, M.J. (1984a) Biosynthesis and processing of phytohemagglutinin in developing bean cotyledons. Eur. J. Biochem. 141, 97-104.

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Pietrini, G., Aggujaro, D., Carrera, P., Malyszko, J., Vitale, A. and Borgese, N. (1992) A single mRNA, transcribed from an alternative, erythroid-specific, promoter, codes for two non-myristylated forms of NADH-cytochrome b5 reductase. J. Cell Biol. 117, 975-986.

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Baldan, B., Guzzo, F., Filippini, F., Gasparian, M., LoSchiavo, F., Vitale, A., de Vries, S., Mariani, P. and Terzi, M. (1997) The secretory nature of the lesion of carrot cell variant ts11, rescuable by endochitinase. Planta, 203, 381-389.

Giovinazzo, G., Greco, V., Vitale, A. and Bollini, R. (1997) Bean (*Phaseolus vulgaris L.*) protoplasts as a model system to study the expression and stability of recombinant seed proteins. **Plant Cell Rep.** 16, 705-709.

Pedrazzini E., Giovinazzo, G., Bielli, A., de Virgilio, M., Frigerio, L., Pesca, M., Faoro, F., Bollini, R., Ceriotti, A. and Vitale, A. (1997) Protein quality control along the route to the plant vacuole. **Plant Cell** 9, 1869-1880.

Crofts, A., Leborgne-Castel, N., Pesca, M., Vitale, A., and Denecke, J. (1998) BiP and calreticulin form an abundant complex that is independent of endoplasmic reticulum stress. Plant Cell 10, 813-823.

Frigerio, L., Vitale, A., Lord, J.M., Ceriotti, A. and Roberts, L.M. (1998) Free ricin A chain, proricin, and native toxin have different cellular fates when expressed in tobacco protoplasts. **J. Biol. Chem.** 273, 14194-14199.

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Frigerio, L., Vine, N.D., Pedrazzini, E., Hein, M.B., Wang, F., Ma, J. K-C., and Vitale, A. (2000) Assembly, secretion and vacuolar delivery of a hybrid immunoglobulin in plants. **Plant Physiol.** *123*, 1483-1493.

Frigerio, L., Foresti, O., Hernández Felipe, D., Neuhaus, J-M,. and Vitale, A. (2001) The C-terminal tetrapeptide of phaseolin is sufficient to target green fluorescent protein to the vacuole. **J. Plant Physiol.** 158, 499-503.

Frigerio, L., Pastres, A., Prada, A., and Vitale, A. (2001) Influence of KDEL on the fate of trimeric or assembly-defective phaseolin: selective use of an alternative route to vacuoles. Plant Cell 13, 1109-1126.

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Nuttall, J., Vitale, A., and Frigerio, L. (2003) C-terminal extension of phaseolin with a short methionine-rich sequence can inhibit trimerisation and result in high instability. **Plant Mol. Biol.** *51*, 885-894.

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Park, M., Kim, S.J., Vitale, A., and Hwang I. (2004) Identification of the protein storage vacuole and protein targeting to the vacuole in leaf cells of three plant species. **Plant Physiol**. *134*, 625-639.

Cervelli, M., Di Caro, O., Di Penta, A., Angelini, R., Federico, R., Vitale, A. and Mariottini, P. (2004) A novel C-terminal sequence from barley polyamine oxidase is a vacuolar sorting signal. Plant J. 40, 410-418.

Mainieri, D., Rossi, M., Archinti, M., Bellucci, M., De Marchis, F., Vavassori, S., Pompa, A., Arcioni, S. and Vitale A. (2004) Zeolin. A new recombinant storage protein constructed using maize gamma-zein and bean phaseolin. **Plant Physiol**. *136*, 3447-3456.

Castelli, S. and Vitale, A. (2005) The phaseolin vacuolar sorting signal promotes transient, strong membrane association and aggregation of the bean storage protein in transgenic tobacco. J. Exp. Bot. 56, 1379-1387.

Pompa, A. and Vitale, A. (2006) Retention of a bean phaseolin/maize γ-zein fusion in the endoplasmic reticulum depends on disulfide bond formation. Plant Cell 18, 2608-2621.

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